

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400



PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Michael J. GREENSIDE, et al.

Confirmation No.: 3308

Application No.: 09/976,997

Examiner:

Filing Date: 10/11/01

Group Art Unit:

Title: COMPACT PERIPHERAL COMPONENT INTERCONNECT KEYED FILLER PANEL

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NON-COMPLIANT APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Non-Compliant Appeal Brief mailed on 01/25/06

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 0. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Signature: Desiree Reardon

Respectfully submitted,

Michael J. GREENSIDE, et al.

By John P. Wagner, Jr.

John P. Wagner, Jr.

Attorney/Agent for Applicant(s)

Reg No. : 35,398

Date : 02/09/06

Telephone : (408) 938-9060



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Greenside et al.

Patent Application

Serial No.: 09/976,997

Group Art Unit: 2831

Filed: October 11, 2001

Examiner: Lee, J.

For: Compact Peripheral Component Interconnect Keyed Filler Panel

Amended Appeal Brief

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Real Party in Interest

The assignee of the present invention is Hewlett-Packard Company.

Related Appeals and Interferences

There are no related appeals or interferences known to the Appellant.

Status of Claims

Claims 1-4 and 6-8 stand rejected. Rejections of claims 1-4 and 6-8 are herein appealed.

Status of Amendments

All proposed amendments have been entered. An amendment subsequent to the Final Action has not been filed.

Summary of Claimed Subject Matter

In accordance with Independent Claim 1, one embodiment of the present claimed invention pertains to a keyed filler panel assembly. The assembly comprises a filler panel body (item 202 of Figures 2 and 3 and page 10 lines 4-16). The assembly further comprises a locating element (item 208 of Figures 2 and 3 and page 10 lines 4-16) coupled to the filler panel body, the locating element orienting the filler panel body with respect to a computer chassis such that interference generating movement of the filler panel body is reduced.

The assembly further comprises an attaching device (item 204 of Figures 2 and 3 and page 10 lines 14-16) adapted to be coupled to the filler panel body, the attaching device for removably coupling the filler panel body to the chassis.

The assembly further comprises an electromagnetic interference (EMI) shield portion (item 206 of Figure 2 and page 8 lines 13-20) coupled to the filler panel body, the EMI shield portion adapted to prevent EMI leakage from the chassis.

In the assembly, the locating element is coupled to the filler panel body at a location such that the locating element will insert into a mounting hole disposed on the chassis in accordance with a compact peripheral component interconnect (CPCI) standard (item 208 of Figures 2 and 3 and page 10 lines 18-29).

In the assembly, the locating element comprises a head portion (item 400 of Figure 4 and page 8 lines 22-39). In the assembly, the locating element further comprises an insertion portion (item 402 of Figure 4 and page 8 lines 22-

39) coupled to the head portion, the insertion portion adapted to be inserted into an opening in the chassis to reduce the interference generating movement of the filler panel body with respect to the chassis.

In the Claimed assembly, the locating element is coupled to the filler panel body at a location such that the locating element coupled to the filler panel body such that the head portion is flush with the filler panel body (items 400 and 202 of Figures 2 and 3 and page 8 lines 26-29).

In the assembly, the locating element further comprises a retention portion (item 404 of Figure 5 and page 8 line 32-39) coupled to the head portion, the retention portion adapted to enhance coupling of the locating element and the filler panel body.

Grounds of Rejection to be Reviewed on Appeal

1. Claims 1-3 stand rejected under 35 U.S.C. 102(b) as being anticipated by Radloff (US005575546A).

2. Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Radloff (US005575546A).

3. Claims 6-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Radloff (US005575546A) in view of Jones et al. (US3986544).

Arguments

1. Whether Claims 1-3 are anticipated under 35 U.S.C. 102(b) by Radloff (US005575546A).

A. Scope and Content of the Cited Prior Art References (Radloff, Jones et al.)

Radloff is relied upon to anticipate an assembly comprising: a filler panel body (14); and a locating element (16f, post) coupled to the filler panel body, the locating element orienting the filler panel body with respect to a computer chassis (16) such that interference generating movement of the filler panel body is reduced (see figure 1 and column 3 lines 45-46 according to the numbering in the middle).

Radloff is additionally relied upon to anticipate an assembly comprising: an attaching device (16g, tab) adapted to be coupled to the filler panel body, the attaching device for removably coupling the filler panel body to the chassis (see figure 1). Note that, it has been held that the recitation that an element is adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutch/son, 69 USPQ 138.

Radloff is further relied upon to anticipate an assembly comprising: an electromagnetic interference shield portion (unnumbered, outer edges of 14a as well as 16f, 16g and 161 for example) coupled to the filler panel body, the shield portion adapted to prevent EMI leakage from the chassis (see figure 1 and column 6 lines 13-15). Note that, it has been held that the recitation that an

element is adapted to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutch/son, 69 USPQ 138.

Radloff is also relied upon to teach an assembly as set forth in claim 1 with the locating element coupled to the filler panel body at a location such that the locating element will insert into a mounting hole disposed on the chassis. Radloff does not explicitly disclose that the assembly is in accordance with a compact peripheral component interconnect standard. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the assembly that is in accordance with a compact peripheral component interconnect standard, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Jones is relied upon to teach a locating element (1, screw member) with an insertion portion (3, shank) coupled to a head portion (2, head), the insertion portion adapted to be inserted into an opening (see figure 7).

B. Differences Between the Cited Prior Art References and the Claimed Invention.

Independent Claim 1 recites the feature “a keyed filler panel assembly comprising... a locating element coupled to the filler panel body.” The features are described in the Detailed Description (such as page 8 lines 22-39 among others) and clearly shown in the Figures (e.g., Figures 2 and 3).

With respect to Radloff, appellant has reviewed Radloff and respectfully disagrees with the Examiner's assertion that Radloff discloses a locating element as a portion of the filler panel body assembly. The Examiner has stated that the post 16f of Radloff is analogous to the locating element of the present invention. However, Appellant understands the post 16f of Radloff to be an integral part of the chassis assembly 16, not an integral part of the filler panel body assembly 14 as described and Claimed in the present invention. Figure 1 of Radloff clearly labels the subcomponents alphabetically based on the component. For example, the filler panel body components of Radloff are labeled numerically and alphanumerically starting with the number 14 while the chassis components of Radloff are labeled numerically and alphanumerically starting with a 16. Therefore, 16f of Radloff would be a component of the chassis assembly not a component of the filler panel body assembly. This is supported in Radloff's Figure 1 and detailed description thereof.

Appellant respectfully points out that the feature of the keyed filler panel assembly with a locating element coupled to the filler panel body as Claimed in the present application is a complete filler panel assembly prior to the final coupling of the filler panel body with the chassis. That is, the locating element is a portion of the filler panel body assembly regardless of whether the filler panel body assembly is coupled with a chassis assembly. Thus, Appellant respectfully states that Radloff does not anticipate the feature of a filler panel body assembly with a locating element.

For this reason, Appellant respectfully asserts that the basis for rejecting Claim 1 under 35 U.S.C. § 102(b) is overcome.

In addition, during a telephone interview, Appellant argued that the preamble stating “keyed filler panel assembly” excludes the thought that the locating element be on the chasses and not on the filler panel. The Examiner disagreed and argued that the Claim language requires a location element “coupled to” the filler panel and that Radloff meets the Claim Language. Appellant respectfully disagrees with the Examiners understanding of the Claim language. Appellant respectfully asserts that MPEP 706.02 clearly points out that for anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.

However, as previously stated, Appellant does not understand the filler panel assembly of Radloff to include a locating element. Moreover, Appellant understands the chassis assembly of Radloff to include the locating element. Therefore, Radloff does not teach a filler panel assembly with a locating element.

For this additional reason, Appellant respectfully asserts that the basis for rejecting Claim 1 under 35 U.S.C. § 102(b) is overcome.

Moreover, Claim 1 clearly states, “A keyed filler panel assembly comprising: a filler panel body; and a locating element coupled to the filler panel body...” Appellant respectfully points out that the word comprises has been construed to mean, in patent law, “including the following elements but not excluding others.” *Moleculon research corp. V. cbs, inc*, 229 u.s.p.q (bna)805, 812 (fed. Cir. 1986).

Appellant respectfully asserts that the filler panel (14) of Radloff does not include the locating element (16f). Therefore, the Claimed features of "A keyed filler panel assembly comprising: a filler panel body; and a locating element coupled to the filler panel body..." are not anticipated by Radloff.

For this additional reason, Appellant respectfully asserts that the basis for rejecting Claim 1 under 35 U.S.C. § 102(b) is overcome.

Further, Appellant respectfully points out that MPEP 2131 clearly states to anticipate a Claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *verdegaal bros. V. Union oil co. Of california*, 814 f.2d 628, 631, 2 uspq2d 1051, 1053 (fed. Cir. 1987).

Moreover, MPEP § 2131.02 states "the identical invention must be shown in as complete detail as is contained in the ... Claim." *richardson v. Suzuki motor co.*, 868 f.2d 1226, 1236, 9 uspq2d 1913, 1920 (fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re bond*, 910 f.2d 831, 15 uspq2d 1566 (fed. Cir. 1990).

Again, Appellant respectfully asserts that the filler panel assembly (14) of Radloff does not include the locating element (16f). Therefore, the Claimed features of "A keyed filler panel assembly comprising: a filler panel body; and a

locating element coupled to the filler panel body...” are not anticipated by Radloff.

For this additional reason, Appellant respectfully asserts that the basis for rejecting Claim 1 under 35 U.S.C. § 102(b) is overcome.

To summarize, Claim 1 recites the feature “a keyed filler panel comprising... a locating element coupled to the filler panel body.” Appellant does not understand Radloff et al. to teach a filler panel body assembly having a locating element. As such, Appellant respectfully submits that the basis for rejecting Claim 1 under 35 U.S.C. § 102(b) is overcome.

Claims 2-3 depend from Claim 1. Appellant respectfully submits that the basis for rejecting Claims 2 – 3 under 35 U.S.C. § 102(b) is overcome as these claims depend from an allowable base claim.

2. Whether Claim 4 is unpatentable over Radloff (US005575546A) under 35 U.S.C. 103(a).

Claim 4 depends from Claim 1. Appellant respectfully submits that the basis for rejecting Claim 4 under 35 U.S.C. § 103(a) is overcome as this claim depends from an allowable base claim.

3. Whether Claims 6-8 are unpatentable over Radloff (US005575546A) in view of Jones et al. (US3986544) under 35 U.S.C. 103(a).

Claims 6-8 depend from Claim 1. Appellant respectfully submits that the basis for rejecting Claims 6-8 under 35 U.S.C. § 103(a) is overcome as this claim depends from an allowable base claim.

In summary, the Applicant respectfully requests that the Board reverse the Examiner's rejections of claims 1-4 and 6-8.

The Applicant wishes to encourage the Examiner or a member of the Board of Patent Appeals to telephone the Applicant's undersigned representative if it is felt that a telephone conference could expedite prosecution.

Respectfully submitted,

WAGNER, MURABITO & HAO LLP

Date: _____

2/4/06



John P. Wagner

Registration Number: 35,398

WAGNER, MURABITO & HAO LLP
Two North Market Street
Third Floor
San Jose, CA 95113
408-938-9060

Claims Appendix

1. (previously presented) A keyed filler panel assembly comprising:
 - a filler panel body; and
 - a locating element coupled to said filler panel body, said locating element orienting said filler panel body with respect to a computer chassis such that interference generating movement of said filler panel body is reduced.
2. (original) The keyed filler panel assembly of Claim 1 further comprising:
 - an attaching device adapted to be coupled to said filler panel body, said attaching device for removably coupling said filler panel body to said chassis.
3. (original) The keyed filler panel assembly of Claim 1 further comprising:
 - an electromagnetic interference (EMI) shield portion coupled to said filler panel body, said EMI shield portion adapted to prevent EMI leakage from said chassis.
4. (original) The keyed filler panel assembly of Claim 1 wherein said locating element is coupled to said filler panel body at a location such that said locating element will insert into a mounting hole disposed on said chassis in accordance with a compact peripheral component interconnect (CPCI) standard.
5. (canceled)
6. (original) The keyed filler panel assembly of Claim 1 wherein said locating element is comprised of:

a head portion; and

an insertion portion coupled to said head portion, said insertion portion adapted to be inserted into an opening in said chassis to reduce said interference generating movement of said filler panel body with respect to said chassis.

7. (original) The keyed filler panel assembly of Claim 6 wherein said locating element is coupled to said filler panel body such that said head portion is flush with said filler panel body.

8. (original) The keyed filler panel assembly of Claim 6 wherein said locating element is further comprised of:

a retention portion coupled to said head portion, said retention portion adapted to enhance coupling of said locating element and said filler panel body.

9-20 (canceled)

Evidence Appendix

None

Related Proceedings Appendix

None